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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,145	02/17/2004	John S. Erickson	P0935	6057

23735 7590 05/17/2006

DIGIMARC CORPORATION
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BEAVERTON, OR 97008

EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/781,145

Applicant(s)

ERICKSON, JOHN S.

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2-21-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 8-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received. .

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action, when taken together with the cancellation of the rejected claims, is persuasive and, therefore, the finality of that action is withdrawn.
2. Claims 1-20 were pending at the time of the previous Office Action in the case. Claims 1-7, 13, and 15-20 have been cancelled by the latest amendment. Claims 8-12, and 14 are pending and have been examined.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Earnest, US 4,888,798, and Bromley, US 5,819,263.

As for claims 8 and 11, Earnest teaches a method of controlling use of a content object that includes text (abstract), the method including; receiving data representing the object at a user device (col. 2 lines 60-67); receiving at the user device an initial set of data representing usage rights associated with said object (col. 2 lines 60-67); the initial set of data defining a first set of rights that are permitted and a second set of

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rights that are not permitted, (col. 2 lines 60-67 and col. 3 lines 28-35); and upon receiving a request to perform a function using said content, checking said initial set of data representing usage rights to determine whether said function should be allowed (col. 3 lines 28-35). Earnest does not teach that a drag and drop function is among those that are not permitted or that the usage rights not permitted are strictly defined. However Bromley does teach this step (col. 11 lines 5-25). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature of Bromley into the method of Earnest. It would have been desirable to do so as this would allow greater control over the end-user's ability to alter the digital work.

As for claims 9 and 10, the combination of Earnest and Bromley does not teach that a modify, a printing, or a saving function are among those that are not permitted. Yet Official Notice may be taken that such limitations on usage rights are old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate these features into the methods of Earnest and Bromley. It would have been desirable to do so as this would allow greater control over the end-user's ability to alter or distribute the digital work.

As for claim 12, Earnest teaches engaging with a remote server to obtain revised data representing usage rights (col. 3 lines 10-15).

Allowable Subject Matter

5. Claim 14 is allowed.
6. The following is a statement of reasons for the indication of allowable subject matter: The prior art in the field does not teach the combination of features found in claim 14, particularly including where a blocked transmission results in the querying of a remote server to determine criteria for transmission, and if this criteria is met, subsequently receiving an updated set of data defining a second set of rights that are permitted, the second set of rights including transmission rights.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

10/28/2005

Paul Callahan